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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,611	02/15/2001	Craig G. Eisler	109927-130476	9396

25943 7590 02/22/2005

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EXAMINER

HOLMES, MICHAEL B

ART UNIT PAPER NUMBER

2121

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/783,611

**Applicant(s)**

EISLER ET AL.

**Examiner**

Michael B. Holmes

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on December 6, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Office Action</u> .           |



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**Examiner's Detailed Office Action**

**Response to Amendment**

1. This Office Action is responsive to communication received on December 06, 2004, Amendment under 37 CFR § 1.111. Reconsideration and allowance of the present application 09/983,611, filed February 15, 2001, is respectfully requested by applicant. All such supporting documentation has been placed in applicant's file.
2. Claims 1-39 have been examined.
3. Regarding claims 1-26, applicant's has failed overcome the 35 USC § 101 rejection. The complete text of which has been included below.

**Claim Rejections - 35 USC § 101**

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Applicant's invention disclosed in claims 1-26 is directed to nonstatutory subject matter i.e., an *abstract idea*. It is the examiner's position applicant's invention as claimed is not limited

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to a *practical application* in the technological arts. There is nothing within the claims that limit the concepts, queries, and sentence construction to a physical structure. The claims *appear* to be directed towards a method and apparatus performed on a computer. However, examination has revealed no computer or computer-readable medium has been disclosed by applicant.

5. This deficiency can lead to speculation that applicant's invention may be implemented on paper or by some other means not associated with a computing device. Examiner will not speculate as to the intended meaning, and will leave that to applicant to further clarify, since applicant discloses no "certain substances" that have been "transformed or reduced" that is, applicant claims disclose no *specific* computer or computer-readable medium.

6. Furthermore, there is no manipulation of *specific* data representing physical objects or activities constituting what one may classify as pre-computer activity, nor does applicant disclose any *specific* independent physical acts being performed by the invention constituting post-computer activity. As aforementioned, it is the examiner's position the claims as presented are nonstatutory, and merely manipulate *abstract ideas* in general without limitation to a practical application whereby "certain substances" are transformed or reduced on a computer or a computer-readable medium.

7. Therefore, claims 1-26 are rejected under 35 USC § 101.

6. It should be noted that if the claims were amended to recite a "computer," "processor," "computer-implemented," "computer-readable-medium," or whatever word(s) or phrase(s) the written description of the specification recites for that feature of the invention the rejection under 35 USC § 101 would be withdrawn.

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7. The subject matter of Claims 1-26 appears to define over the prior art. However, any indication of allowability is being held in abeyance pending the resolution of the 35 USC § 101 issues.
8. Claims 27-39 are allowed.
9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
10. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### Correspondence Information

11. Any inquires concerning this communication or earlier communications from the examiner should be directed to Michael B. Holmes, who may be reached Monday through Friday, between 8:00 a.m. and 5:00 p.m. EST. or via telephone at (571) 272-3686 or facsimile transmission (571) 273-3686 or email [Michael.holmesb@uspto.gov](mailto:Michael.holmesb@uspto.gov).

If you need to send an Official facsimile transmission, please send it to (703) 746-7239.

If attempts to reach the examiner are unsuccessful the Examiner's Supervisor, Anthony

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Knight, may be reached at (571) 272-3687.

Hand-delivered responses should be delivered to the Receptionist @ (Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22313), located on the first floor of the south side of the Randolph Building.

***Michael B. Holmes***

Patent Examiner

Artificial Intelligence

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United States Department of Commerce

Patent & Trademark Office

*Wednesday, February 16, 2005*

*MBH*

A handwritten signature in black ink, appearing to read 'Anthony Knight', with a stylized flourish at the end.

**Anthony Knight**

**Supervisory Patent Examiner**

**Group 3600**